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21876 7590 09/06/2007 FISH & RICHARDSON P.C. P.O. Box 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER GERGISO, TECHANE	
			ART UNIT 2137	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/656,593

**Applicant(s)**

GOLDMAN, OLIVER

**Examiner**Techane J. Gergiso *TG***Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08/01/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14, 18, 20-39 and 43-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 11-14, 18, 20-31, 36-39 and 43-54, 59-62 is/are rejected.
- 7) ☒ Claim(s) 7-10, 32-35 and 55-58 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. This is a Final Office Action in Response to the applicant's communication filed on June 22, 2007.
2. The applicant canceled claims 15-17, 19, and 40-42.
3. The applicant added new claims 49-62.
4. The applicant amended claims 1-4, 8-14, 18, 20-29, 33-39 and 43-48.
5. Claims 1-14, 18, 20-39 and 43-62 are pending.

### *Claim Rejections - 35 USC § 112*

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claims, 1 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps.

See MPEP § 2172.01. The omitted steps are:

A digital signature right information and a digital signature module are embedded within a document to be access by the application (disclosure page 3, lines 10-17).

To access the document and perform a digital signature operation using the digital signature module by the user application, the step of first extracting the embedded

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digital signature right information and the digital signature module from the document is essential. The step of authenticating the extracted digital signature right information and digital signature module is also necessary before performing the digital signature operation on the document. These essential steps are also disclosed in figure 3 items 310-325 of the instant application.

Figure 3

310: Extract attached digital signature module

315: Extract digital signature rights information

320: Authenticate attached digital signature module and digital signature rights information

325: Enable digital signature operations

9. Claims 2-14, 27-39 and 50-62 are also rejected under 35 U.S.C. 112, second paragraph based on their dependencies from their corresponding independent claims 1 and 26.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. Claims 1-14, 18, 20-39 and 43-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narishima et al. (hereinafter referred to as Narishima; US. Pub. No.: 2002/0157006) in view of Watanabe et al. (hereinafter referred to as Watanabe, US Pat. No.: 7,152,158).

As per claims 1, 26, and 49:

Narishima discloses a computer implemented method, a computer program product implement a user application, and a computer system comprising:

accessing a first electronic document using a user application, the first electronic document including digital signature rights information and a digital signature module, the digital signature module being operable to perform digital signature operations on the first electronic document (figure 3:content data 1; 21110, 22010, 20010: signature; figure 7: 135: application; run application program based on rule verification result) and

using the digital signature module to perform one or more of the digital signature operations on the first electronic document in the user application (figure 7: 135: application; run application program based on rule verification result)

identifying a second electronic document, the second electronic document being a document other than the first electronic document (figure 3: content data 2 different from content data 1); and

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using the digital signature module to perform one or more of the digital signature operations on the second electronic document in the user application (figure 3: signature (applicant, accounting, general affairs section)).

Narishima does not explicitly disclose the second document being identified in the digital signature rights information of the first electronic document and digital signature module. Watanabe, in analogous art however, disclose the electronic document including a digital signature module (column 5: lines 65-67; column 5: lines 1-13; attaching a digital signature on message data constituting the public key certificate in accordance with the different signature algorithm at each certificate authority, and issuing a multi-signed public key certificate storing a plurality of signatures based on different signature algorithms). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the method disclosed by Narishima to include the second document being identified in the digital signature rights information of the first electronic document and digital signature module. This modification would have been obvious because a person having ordinary skill in the art would have been motivated by the desire to provide a plurality of certificate authorities having a configuration for executing processing of storing a generated signature into an area other than a basic area and an extended area of the public key certificate and storing signature information including signature algorithm information associated with the generated signature into the extended area as suggested by Watanabe (column 5: lines 30-40).

As per claims 2, 27 and 50:

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Watanabe discloses a method, wherein using the digital signature module includes: validating the digital signature module (column 11: lines 1-14; signature algorithm, verify the public key certificate for its validity); and using the digital signature module to perform other digital signature operations only if the digital signature module is validated (column 12: lines 29-32).

As per claims 3, 28 and 51:

Narishima discloses a computer implemented method, a computer program product implement a user application, and a computer system, wherein using the digital signature module includes signing the first and second electronic documents (figure 3: signature).

As per claims 4, 29 and 52:

Watanabe discloses a computer implemented method, a computer program product implement a user application, and a computer system, wherein using the digital signature module includes authenticating a digital signature in the first and second electronic documents (column 16: lines 45-62; column 17: 35-55)

As per claims 5, 30 and 53:

Narishima discloses a computer implemented method, a computer program product implement a user application, and a computer system, wherein using the digital signature module includes using the digital signature module running on a server (figure 6: application server; rule verification library).

As per claims 6, 31 and 54:

Watanabe discloses a computer implemented method, a computer program product implement a user application, and a computer system, wherein including the digital signature module includes including a reference to the digital signature module (figure 21: 702a-702n)

As per claims 11, 36 and 59:

Narishima discloses a computer implemented method, a computer program product implement a user application, and a computer system, wherein using the digital signature module includes performing a digital signature operation on a portion of the first or second electronic document or on a user added content portion of the first or electronic document (0045, 0046 ; content application 135).

As per claims 12, 37 and 60:

Narishima discloses a computer implemented method, a computer program product implement a user application, and a computer system, wherein receiving input adding content to the first or second electronic document in the user application, wherein using the digital signature module includes performing a digital signature operation on the added content (0045, 0046; content application 135).

As per claims 13, 38 and 61:

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Narishima discloses a computer implemented method, a computer program product implement a user application, and a computer system, wherein receiving input modifying content of the first or second electronic document in the user application, wherein using the digital signature module includes performing the digital signature operations on the modified content (0045, 0046; content application 135).

As per claim 18:

Narishima discloses a electronic document, comprising:

electronic content (figure 3: content data);

digital signature rights information, the digital signature rights information identifying one or more other electronic documents, each one or more other electronic documents comprising electronic content, the digital signature rights information enabling one or more operations on the electronic document and the one or more other electronic documents (figure 3:content data 1; 21110, 22010, 20010: signature; figure 7: 135: application; run application program based on rule verification result); and

performing operation on the electronic content of the electronic document and the electronic content of the one or more other electronic documents (figure 3: content data 2 different from content data 1; applicant, accounting, general affairs section).

Narishima does not explicitly disclose a digital signature module, the digital signature module being operable upon loading to perform digital signature operations (column 5: lines 65-67; column 5: lines 1-13; attaching a digital signature on message data constituting the public

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key certificate in accordance with the different signature algorithm at each certificate authority, and issuing a multi-signed public key certificate storing a plurality of signatures based on different signature algorithms). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the method disclosed by Narishima to include a digital signature module, the digital signature module being operable upon loading to perform digital signature operations. This modification would have been obvious because a person having ordinary skill in the art would have been motivated by the desire to provide a plurality of certificate authorities having a configuration for executing processing of storing a generated signature into an area other than a basic area and an extended area of the public key certificate and storing signature information including signature algorithm information associated with the generated signature into the extended area as suggested by Watanabe (column 5: lines 30-40).

As per claims 20 and 43:

Narishima discloses a computer implemented method and a computer program product implement a user application, comprising:

receiving a signed first electronic document, the first electronic document including digital signature rights information, a digital signature module and a digital signature generated by the digital signature module, the digital signature module being operable to perform digital signature operations including (figure 5: :1001-1008; figure 6: 112, 134, 141, 144)

accessing the first electronic document in a user application (figure 3: 135; content data;

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accessing a second electronic document, the second electronic document being a document other than the first electronic document, the second electronic document being identified by the digital signature rights information in the first electronic document; and performing digital signature operations on the second electronic document (figure 3: content data 2 different from content data 1; (figure 3: signature (applicant, accounting, general affairs section))).

Narishima does not explicitly disclose the second document being identified in the digital signature rights information of the first electronic document and digital signature module. Watanabe, in analogous art however, disclose the electronic document including a digital signature module and validating the digital signature in the first electronic document using the digital signature module in the user application (column 5: lines 65-67; column 5: lines 1-13; attaching a digital signature on message data constituting the public key certificate in accordance with the different signature algorithm at each certificate authority, and issuing a multi-signed public key certificate storing a plurality of signatures based on different signature algorithms; column 11: lines 1-14; signature algorithm, verify the public key certificate for its validity). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the method disclosed by Narishima to include the second document being identified in the digital signature rights information of the first electronic document and digital signature module. This modification would have been obvious because a person having ordinary skill in the art would have been motivated by the desire to provide a plurality of certificate authorities having a configuration for executing processing of storing a

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generated signature into an area other than a basic area and an extended area of the public key certificate and storing signature information including signature algorithm information associated with the generated signature into the extended area as suggested by Watanabe (column 5: lines 30-40).

As per claims 21 and 44:

Narishima discloses a computer implemented method, a computer program product implement a user application performing a digital signature operation embedding digital signature information in the first or second electronic document, the digital signature operation being performed using the digital signature module after optionally modifying the first or second electronic document; and transmitting the first or second electronic document, including the embedded digital signature module and the digital signature information (0045, 0046 ; content application 135).

12. Claims 14, 39 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narishima et al. (hereinafter referred to as Narishima; US. Pub. No.: 2002/0157006) in view of Watanabe et al. (hereinafter referred to as Watanabe, US Pat. No.: 7,152,158) and further in view of Parmelee et al (hereinafter referred to as Parmelee; US. Pub. No.: 2002/0129256).

As per claims 14, 39 and 62:

Narishima and Watanabe do not explicitly disclose the electronic document is a PDF document. Parmelee, in analogous art, however, discloses the electronic document is a PDF document

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(Column 13: lines 10-31; Figure 9C: 163). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system disclosed by Narishima and Watanabe to include the electronic document is a PDF document. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so to provide a system and method which can be easily employed by individuals for protecting electronic documents as suggested by Parmelee in (Page 1: 0009-0012).

13. Claims 22-25 and 45-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narishima et al. (hereinafter referred to as Narishima; US. Pub. No.: 2002/0157006) in view of Watanabe et al. (hereinafter referred to as Watanabe, US Pat. No.: 7,152,158) and further in view of Kinnis et al. (hereinafter referred to as Kinnis; US. Pat. No.: 6,959,382).

As per claims 22 and 45:

Narishima discloses a computer implemented method, and a computer program product implement a user application, wherein receiving a signed first electronic document includes; and transmitting the first electronic document includes transmitting the first electronic document to another user (0045, 0046; content application 135).

Narishima and Watanabe do not explicitly disclose receiving the signed first electronic document as a user in a multi-user sequence defined by a workflow. Kinnis, in analogous art, however, discloses receiving the signed first electronic document as a user in a multi-user

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sequence defined by a workflow (Figure 9: 940, 945). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system disclosed by Narishima and Watanabe to include receiving the signed first electronic document as a user in a multi-user sequence defined by a workflow. This modification would have been obvious because a person having ordinary skill in the art would have been motivated to do so to generate digital signatures that are not specific to an application, such as an email client. The digital signature service also provides the functionality to obtain certificates, manage private--public keys, and generate digital signatures for documents that may be stored independent of other tools used by the user as suggested by Kinnis in (column 2: lines 20-25).

As per claims 23 and 46:

Kinnis discloses a computer implemented method, and a computer program product implement a user application, wherein performing the digital signature operation includes performing the digital signature operation on a portion of the first or second electronic document; and transmitting the first or second electronic document includes transmitting only the portion of the first or second electronic document on which the digital signature operation is performed (column 5: lines 56-67, column 6: lines 1-15).

As per claims 24 and 47:

Kinnis discloses a computer implemented method, and a computer program product implement a user application, comprising receiving input adding content to the first or second electronic document in the user application, wherein using the digital signature module includes

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performing a digital signature operation on the added content (column 5: lines 56-67, column 6: lines 1-15).

As per claims 25 and 48:

Kinnis discloses a computer implemented method, and a computer program product implement a user application, comprising receiving input modifying content of the first or second electronic document in the user application wherein using the digital signature module includes performing a digital operation on the modified content (column 5: lines 56-67, column 6: lines 1-15).

### ***Allowable Subject Matter***

14. Claims 7-10, 32-35 and 55-58 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. The following is a statement of reasons for the indication of allowable subject matter:

The recipient of the electronic document uses the public key certificate to retrieve a public key corresponding to the received public key certificate. The recipient typically uses the digital signature application to generate a digest of the electronic document, and uses the digest along with the public key to verify the attached digital signature. However there are a number of different digital signature applications that implement different digital signature protocols. As a result, it can be difficult to ensure that recipients of a particular electronic document will have

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access to a particular digital signature algorithm. The claimed invention provides a technique include accessing an electronic document using a user application, where the electronic document includes a digital signature module, and using the digital signature module to perform one or more digital signature operations on one or two electronic document in the user application.

### ***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the notice of reference cited in form PTO-892 for additional prior art

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

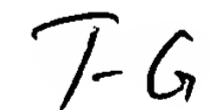
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Contact Information***

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Techane J. Gergiso whose telephone number is (571) 272-3784 and fax number is (571) 273-3784. The examiner can normally be reached on 9:00am - 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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Art Unit 2137

August 31, 2007